

REMARKS/ARGUMENT

The present Response is being filed under a Certificate of Mailing as indicated.

Claims 1-2, 6-7, 24-25 and 35-36 are pending and read on the elected species of FIGS. 1-2.

Claims 1 and 6 have been amended. Claims 3-4, 8-9 and 26 have been withdrawn. To expedite prosecution, claims 27-34 have been cancelled; claims 5 and 10-23 were previously cancelled. Applicants reserve the right to proceed with these cancelled claims in a continuation or divisional application.

Claim Rejections – 35 USC §112

The rejection of claims 1-2 and 6-7 under 35 USC §112 is respectfully traversed. By this amendment, independent claim 1 has been amended to indicate that the maximum dimension of the first component in the proximal-distal direction is the distance from the distal articulating surface to the proximal end. Independent claim 6 similarly indicates that the maximum proximal-distal dimension of the first component is the distance from the distal articulating surface to the proximal end.

The Office Action indicates that “it is unclear what reference point on the articulating surface is being used to measure the distance.” However, these claims indicate that this distance is the maximum proximal-distal dimension of the first component; there can only be one maximum proximal-distal dimension. Read together with other claim elements, the tapered bore is at the proximal end, and is therefore positioned at the maximum proximal-distal dimension of the first component.

“The test for definiteness under standard under 35 U.S.C. 112 is whether ‘those skilled in the art would understand what is claimed when the claim is read in light of the specification.’ [citation omitted]” MPEP §2173.02. Here, anyone of ordinary skill in the art can determine: where the maximum proximal-distal dimension of the component is located; whether this location corresponds with the distance between the proximal end and some position on the distal articulating surface; and whether a tapered bore is located at the proximal end. Accordingly, claims 1 and 6 meet the test for definiteness under 35 U.S.C. 112 and claims 1-2 and 6-7 are patentable under 35 U.S.C. 112.

Claim Rejections – 35 USC §102

The rejection of claims 1-2 under 35 USC §102(b) as being anticipated by O’Neil et al. (US 6,071,311) is respectfully traversed.

In the Office Action, elements 46 and 46’ of O’Neil et al. are identified as “tapered bores”. However, as shown in O’Neil et al.’s FIGS. 2B and 5B, elements 46 and 46’ are not located at the proximal end, are not located at the maximum proximal-distal dimension of the component and are not widest at the proximal end. In addition, the maximum proximal-distal dimension of the O’Neil et al. component is not at the holes 46 and 46’. Considering the assembly of elements 16 and 70 of O’Neil et al. to comprise an adapter, the end of the assembly associated with element 70 does not appear to be tapered and is not described in O’Neil et al. as being tapered. For all of these reasons, O’Neil et al. does not anticipate claim 1. Accordingly, claims 1-2 and 35-36 are patentable over O’Neil et al.

The rejection of claims 6-7 under 35 USC §102(b) as being anticipated by O’Neil et al. (alternate interpretation) is respectfully traversed. As shown in O’Neil et al.’s FIGS. 2B

and 5B, elements 46 and 46' are not located at the proximal end, are not located at the maximum proximal-distal dimension of the component and are not widest at the proximal end. In addition, element 70 of O'Neil et al. is described at col. 5, lines 5-18 as a shaft portion of a bolt 20 that may be threaded; the bolt 20 also includes a head 72. The head 72 is wider than the neck portion 70B and the upper portion 70A (see O'Neil et al. col. 5, lines 9-14). Accordingly, the assembly of elements 16 and 70 is not most narrow at its two ends; instead, it is most narrow at the neck portion 70B which is spaced from the end. Finally, the maximum proximal-distal dimension of the O'Neil et al. component is not at the holes 46 and 46'. For all of these reasons, O'Neil et al. does not anticipate claim 6. Accordingly, claims 6-7 are patentable over O'Neil et al.

The rejection of claims 24-25 under 35 USC §102(b) as being anticipated by O'Neil et al. (alternate interpretation) is respectfully traversed. Element 70 of O'Neil et al. is described at col. 5, lines 5-18 as a shaft portion of a bolt 20 that may be threaded; the bolt 20 also includes a head 72. The head 72 is wider than the neck portion 70B and the upper portion 70A (see O'Neil et al. col. 5, lines 9-14). Accordingly, the assembly of elements 16 and 70 is *not* most narrow at its two ends; instead, it is most narrow at the neck portion 70B, which is spaced from the end. For all of these reasons, O'Neil et al. does not anticipate claim 24. Accordingly, claims 24-25 are patentable over O'Neil et al.

CONCLUSION

If any fees are required, the Examiner is hereby authorized to debit deposit account no. 10-0750/DEP5111NP/SJM.

For the above-described reasons it is respectfully submitted that the rejections to the claims that were not canceled or withdrawn have been overcome and that claims 1-2, 6-7, 24-25 and 35-36 are currently in condition for allowance. Reconsideration, further examination and a Notice of Allowance are respectfully requested.

Respectfully submitted,

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